SUPREME COURT OF THE UNITED STATES

NO. 471

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1960

NO. 471

PREFORMED LINE PRODUCTS COMPANY,
Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
Respondent

Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

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PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

Respondent's Questions Presented Are Erroneous

Respondent asserts that only two questions are presented in the pending petition for certiorari (Res. Br. 2). Both of Respondent's questions presented are inaccurate and misleading, the first being derived from facts which lead to Petitioner's second question presented; Respondent's second question presented being derived from facts to which Petitioner's fifth and sixth questions presented are addressed (Pet. 2, 3).

RESPONDENT'S FIRST QUESTION

It is not important here that the claims involved in the interference between Petitioner's assignor, Peterson, and the patentee Bodendieck were ultimately denied Peterson on the grounds that his applications lacked basis in their disclosures to support them. This was merely an *ex parte* reiteration by the Examiner of the *inter partes* ruling in the case by the Interference Board.[1]

What is important here is that the claims in question had already been adjudged patentable by the Commissioner of Patents and had actually been patented to Bodendieck (Joint App. 508, 511, Claims 1 and 2). This was a proper exercise of the administrative function vested in the Commissioner of Patents by the Congress under the provisions of Article I, Section 8 of the Constitution. No issue was raised in the pleadings nor on the trial before the District Court concerning these claims. The Court, *sua sponte*, held that these claims were not directed to patentable subject matter, thus, in effect, supervening the Commissioner's judgment to the contrary.

The issue is, therefore, not whether the Court has jurisdiction to find novelty lacking in *rejected* claims, as asserted in Respondent's first question presented; rather, whether the Court has jurisdiction to adjudge as unpatentable *patented* claims whose novelty (or patentability *vel non*) was not in issue, as asserted in Petitioner's second question presented.

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1. The Board of Appeals in a precedential *ex parte* appeal had already decided that there was basis to support these claims in Peterson's first application. It is Petitioner's position, not that prior *ex parte* decisions are binding on subsequent *inter partes* proceedings, but are binding on subsequent *ex parte* proceedings that follow the *inter partes* action when nothing eventuated in the latter to change the precedential *ex parte* status. Compare this with the note in the margin of Respondent's brief, p. 8.

RESPONDENT'S SECOND QUESTION

Respondent's apprehension of the second question presented is wrong because it is predicated upon certain assumptions in prejudgment of the ultimate issues before the Court. In the first place, Respondent has assumed that the judgment of the Interference Board is a *final* judgment. Petitioner asserts that *it was not a final judgment.* The facts are recited in the full paragraph of page 6 of the petition.

The Interference Statute[2] provides for the determination of the question of priority of invention between applicants for patent or between an applicant and a patentee. There must be rival claimants.[3] Here, Peterson copied Claims 1 and 2 of Bodendieck's issued patent into his pending application, and made them a matter of original record in his second application. An interference evolved, between Peterson and Bodendieck who became rival claimants for this patented subject matter. The Interference Board denied basis in either Peterson application to support the patented claims.[4] From this judgment notice of appeal to the CCPA was given. At this juncture, before the record was forwarded to the Court, Bodendieck filed his disclaimer of the patented claims, also, conceded priority to Peterson. Respondent does not deny that the interference was pending in good standing when this action was taken.

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2. 35 USC §135, reproduced in Pet. App. A-15, A-16.

3. *Lattig & Goodrum* v. *Dean*, 25 App. D.C. 592; 1905 C.D. 698; *Oliver* v. *Felbel*, 20 App. D.C. 262; 1902 C.D. 565.

4. The Interference Board adopted the Examiner's view as to Peterson's lack of disclosure. Acting *inter partes*, the Examiner was not bound by the *ex parte* ruling of the Board of Appeals holding to the contrary.

The law controlling this situation is clearly recited in Patent Office Rules governing patent cases No. 262(a), 262(d), and 263[5], which have the effect of law.[6] It is provided that an applicant or *a patentee* involved in an interference may, *at any time*, file a written disclaimer or concession of priority, whereupon judgment shall be rendered against him; the claims will be automatically stricken, and the interference terminated on this basis. In cases of statutory disclaimer (as here), the interference will be dissolved pro forma as to such claims.

Petitioner seasonably moved the Commissioner to vacate the Interference Board's judgment under the mandate of Rules 262 and 263.[7] The motion was denied December 21, 1950, and the limit of appeal to the CCPA expired the next day. Contrary to Respondent's assertion, Petitioner urges that the interference terminated when the disclaimer was filed by the patentee, and not two weeks later when the limit of appeal to the CCPA expired. The law is clear that the Commissioner must vacate the judgment of the Interference Board, and that *it is mandatory rather than discretionary upon him to do so.* Therefore, contrary to Respondent's second question presented, the Interference Board's judgment was not a *final* judgment, is void in law, and cannot constitute the basis for *res judicata* in the *ex parte* prosecution that ensued.

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5. Petition, 26; Pet. App. A-19, A-20.

6. *Geophysical Development Corp.* v. *Coe*, 136 F.2d 275; 78 U.S. App. D.C. 39; cert. den. 320 U.S. 760. *Gearon et al.* v. *U. S.*, 121 F.S. 652; *Land* v. *Dreyer*, 155 F.2d 383.

7. The District Court found that the Commissioner of Patents had original jurisdiction in this case. Attention is invited to page 6, note 7 in the margin of the petition; Court Order p. A-5, and Conclusions of Law 15 at p. A-14.

Conclusion

The jurisdictional issues raised by this petition, recited in Petitioner's questions presented, are of first importance in the public interest as well as in the interest of Petitioner.

The Writ should issue.

Respectfully submitted,

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